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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/589,355

06/08/2000

Nobuhisa Yoda

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9981

22428

7590

01/30/2004

FOLEY AND LARDNER

SUITE 500

3000 K STREET NW

WASHINGTON, DC 20007

EXAMINER

VU, KIEU D

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

124

Office Action Summary

Application No.

09/589,355

Applicant(s)

YODA ET AL.

Examiner

Kieu D Vu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-18 is/are rejected.
- 7) ☒ Claim(s) 10 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Regarding claim 6, it is suggested that the term "the presence/absence" be changed to "the presence or absence".

Regarding claim 15, it is suggested that the term "the presence/absence" be changed to "the presence or absence".

Specification

2. The abstract is objected since it exceeds 150 words.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9, 12, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the resultant". There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the password". There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the resultant". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Os et al ("Os", USP 6480304).

Regarding claims 1 and 14, Os teaches an information process system in which an image forming apparatus (Fig. 7) having display input means capable of displaying various operation buttons (col 2, lines 46-51) and effecting input is connected to a communication line and information is processed with a server connected to the communication line (col 9, lines 42-46), wherein the server has formation means for forming operation button information which sets a function to be performed by the image forming apparatus and is to be displayed on the display input means (line 61 of col 2 to line 10 of col 3) and the image forming apparatus comprises registration means for registering the operation button information which sets the function to be performed by

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the image forming apparatus and has been formed by the formation means (col 6, lines 55-67) and control means for executing a control to display an operation button on the display input means, on the basis of the operation button information which sets the function to be performed by the image forming apparatus and has been registered by the registration means (col 6, lines 55-67).

Regarding claim 2, Os teaches that said display input means is an operation panel incorporating a touch panel and effecting input by means of various operation buttons displayed on a liquid crystal display (col 2, lines 47-48, col 58-60).

Regarding claim 3, Os teaches that formation means forms operation button information by activating an operation button function setting section included in the image forming apparatus (col 6, lines 65-67).

Regarding claim 4, Os teaches that that said registration means is a database for managing the operation button information (col 6, lines 55-67).

Regarding claim 5, Os teaches an operation button management section (col 6, lines 65-67).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-9, 11-13, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Os and Keller et al ("Keller", USP 5821933).

Regarding claims 6 and 15, Os teaches an information process system in which an image forming apparatus (Fig. 7) having display input means capable of displaying various operation buttons (col 2, lines 46-51) and effecting input is connected to a communication line and information is processed with a server connected to the communication line (col 9, lines 42-46), wherein the server has formation means for forming operation button information which sets a function to be performed by the image forming apparatus and is to be displayed on the display input means (line 61 of col 2 to line 10 of col 3), and the image forming apparatus comprises registration means for registering the operation button information which sets the function to be performed by the image forming apparatus and has been formed by the formation means (col 6, lines 55-67) and control means for executing a control to display an operation button on the display input means, on the basis of the operation button information which sets the function to be performed by the image forming apparatus and has been registered by the registration means (col 6, lines 55-67) and control means for executing a control to display the operation button on the display input means, on the basis of the operation button information which sets the function to be performed by the image forming apparatus and has been registered by the registration means (col 6, lines 55-67). Os differs from the claim in that Os does not teach the verification means for verifying the Presence or absence of the right of use by using the information for verifying the right of use of the operation button executing a desired function set by the operation button through which input has been effected, when the presence of the right of use has been verified by the verification means. However, the feature of usage right verification is

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known in the art as taught by Keller. In the same field of accessing functions on a graphical user interface, Keller teaches the verifying a right of use of a function (col 2, lines 19-24). Keller further teaches that, upon the presence of the usage right on a function, the corresponding function is executed (col 2, lines 24-28). It would have been obvious to one of ordinary skill in the art, having the teaching of Os and Keller before him at the time the invention was made, to modify the information process system taught by Os to include the usage right verification taught by Keller with the motivation being to provide a high level of security to restricted function being accessed or executed.

Regarding claims 7 and 16, Os teaches a first transfer control means for executing a control to transfer image information read on the basis of preregistered transfer information (col 3, lines 2-6).

Regarding claims 8 and 17, Os teaches storage means for temporarily storing image information transferred from the image forming apparatus, and process means for transferring the image information stored in the storage means on the basis of pre-stored transfer process information (col 9, lines 9-13).

Regarding claims 9 and 18, Os teaches the executing a control to provide read image information with transfer identification information and transfer the resultant information (col 3, lines 2-9).

Regarding claim 11, Os does not teach that the information for verifying the right of use of the operation button is a password. However, the feature of using a password for usage right verification is known in the art as taught by Keller. In the same field of

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accessing functions on a graphical user interface, Keller teaches the verifying a right of use of a function by using a password (col 2, lines 19-28). It would have been obvious to one of ordinary skill in the art, having the teaching of Os and Keller before him at the time the invention was made, to modify the information process system taught by Os to include the usage right verification by using password taught by Keller with the motivation being to use password to provide a high level of security to restricted function being accessed or executed.

Regarding claim 12, Os does not teach that when the password has failed to be verified, performs a process of "re-input". However, the feature is known in the art as taught by Keller. In the same field of accessing functions on a graphical user interface, Keller teaches that when the password verification fails, the system waits for the next password to be entered (col 6, lines 6-11). It would have been obvious to one of ordinary skill in the art, having the teaching of Os and Keller before him at the time the invention was made, to modify the information process system taught by Os to include the process for re-enter the password taught by Keller with the motivation being to enable the user to re-enter the correct password if he or she mistakenly enters incorrect password.

Regarding claim 13, Os teaches a scan image transfer process module (col 3, lines 2-6).

Allowable Subject Matter

10. Claims 10 and 19 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 10 and 19, none of the prior art fairly teaches or suggests the limitations "said server temporarily stores image information transferred from the image forming apparatus and transfer identification information"; "stores transfer process information corresponding to the transfer identification information"; "finds the stored transfer process information by using the temporarily stored transfer identification information"; and "processes transfer of the temporarily stored image information on the basis of the found transfer process information" in a specific combination as cited in claims 10 and 19. These claims define patentably over prior art of record.

12. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach systems for processing information which relates to the claimed invention.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu whose telephone number is (703-605-1232). The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703- 308-3116).

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-872-9306


and / or:

(703)-746-5639 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Kieu D. Vu

01/22/04



JOHN CABECA
SUPERVISORY PATENT EXAMINER
COMMERCIAL CENTER 2100